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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/970,535 | 10/03/2001 | Robert L. Parker | 42390P9334 | 1378 |

8791 7590 12/24/2003

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EXAMINER

O'CONNOR, GERALD J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3627

DATE MAILED: 12/24/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/970,535

Applicant(s)
Parker et al.

Examiner
O'Connor

Art Unit
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 3, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to because Figures 1-3 comprise black and white photographs.

Black and white photographs are acceptable for examination purposes only, unless a petition filed under 37 CFR 1.84(b)(1) is granted permitting their use as acceptable drawings. In the event that applicant wishes to have the photographs on file considered for approval as acceptable drawings, such a petition can be filed, but must be accompanied by the appropriate fee set forth in 37 CFR 1.17(i) and three sets of the photographs. The photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. The photographs must be of sufficient quality so that all details in the photographs are reproducible in a printed patent. See MPEP § 608.02 and 37 CFR 1.84(b)(1).

2. A proposed drawing correction or corrected drawings (or other appropriate corrective action) are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. No new matter should be entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e)¹ the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lunetta et al. (US 2001/0031102).

Lunetta et al. disclose a method comprising: providing a first image of an article of merchandise available to a consumer in an electronic commerce transaction; projecting a second image onto the first image of the article of merchandise to produce a third image representing the article of merchandise as personalized by the second image; and, providing the third image for display to the consumer to facilitate an electronic commerce transaction.

¹ The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

Regarding claims 2, 7, 12, and 15, the method of Lunetta et al. includes the step of accepting an order from the consumer to purchase the article of merchandise as personalized by the second image.

Regarding claims 3, 8, 13, and 16, the method of Lunetta et al. includes the step of fulfilling an order for purchase of the article of merchandise by the consumer, the article of merchandise corresponding to the image of the article of merchandise as personalized with the second image.

Regarding claims 4 and 9, the method of Lunetta et al. includes the step of receiving, by a server computer, the second image from a client device of the consumer, the server computer producing the third image.

Regarding claims 5 and 10, the method of Lunetta et al. includes the step of creating the second image by a server computer as a result of communications received from a client device of the consumer, the server computer producing the third image.

5. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by von Rosen et al. (US 6,493,677).

Von Rosen et al. disclose a method comprising: providing a first image of an article of merchandise available to a consumer in an electronic commerce transaction; projecting a second image onto the first image of the article of merchandise to produce a third image representing the

article of merchandise as personalized by the second image; and, providing the third image for display to the consumer to facilitate an electronic commerce transaction.

Regarding claims 2, 7, 12, and 15, the method of von Rosen et al. includes the step of accepting an order from the consumer to purchase the article of merchandise as personalized by the second image.

Regarding claims 3, 8, 13, and 16, the method of von Rosen et al. includes the step of fulfilling an order for purchase of the article of merchandise by the consumer, the article of merchandise corresponding to the image of the article of merchandise as personalized with the second image.

Regarding claims 4 and 9, the method of von Rosen et al. includes the step of receiving, by a server computer, the second image from a client device of the consumer, the server computer producing the third image.

Regarding claims 5 and 10, the method of von Rosen et al. includes the step of creating the second image by a server computer as a result of communications received from a client device of the consumer, the server computer producing the third image.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to the disclosure.

7. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

December 15, 2003

 12-15-03

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627